

REMARKS

This is a full and timely response to the outstanding Office Action mailed April 10, 2007. Upon entry of the amendments in this response, claims 1-4, 6-8, 10-12, 14, and 15 remain pending. In particular, Applicant has amended claims 1 and 12, and has canceled claim 13 without prejudice, waiver, or disclaimer. Applicant has canceled claim 13 merely to reduce the number of disputed issues and to facilitate early allowance and issuance of other claims in the present application. Applicant reserves the right to pursue the subject matter of this canceled claim in a continuing application, if Applicant so chooses, and does not intend to dedicate the canceled subject matter to the public. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Indication of Allowable Subject Matter

The Office Action indicates that claims 7, 8, 10, 11, and 15 are allowed and that claim 13 would be allowed if rewritten in independent form. As set forth above, Applicant has amended claim 12 to include the limitations previously recited in claim 13. Therefore, claims 7, 8, 10-12, and 15 are believed to be in condition for allowance as indicated in the Office Action.

II. Claim Rejections - 35 U.S.C. § 102(b)

A. Statement of the Rejection

Claims 1-4, 6, 12, and 14 have been rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by *Vance et al.* ("*Vance*," U.S. Pat. No. 5,358,485).

Applicant respectfully traverses this rejection and through amendments to claim 1 and 12 considers these rejections moot as to claims 1-4, 6, 12, and 14.

B. Discussion of the Rejection

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(b).

In the present case, not every feature of the claimed invention is represented in the *Vance* reference. Applicant discusses the *Vance* reference and Applicant's claims in the following.

Claim 1 recites:

1. A flexible tap apparatus member comprising:
a shaft having a first passage disposed axially therein, a second passage communicating with and extending outwardly from said first passage to an outer surface of said shaft, a flexible upper shaft portion, and a flexible lower shaft portion;
said upper shaft portion comprising external threads and said lower shaft portion having a substantially smooth surface; and
a dye;
wherein said flexible tap apparatus member is arranged and configured such that after insertion into a living body, **said upper shaft portion is anchored in a tissue of the living body with the external threads**; and

wherein said first passage and said second passage are sized and shaped to communicate said dye to the tissue into which the upper shaft portion is anchored.
(Emphasis added).

Applicant respectfully submits that the rejection of independent claim 1 and the respective dependent claims under this rejection have been rendered moot. In this regard, Applicant respectfully submits that *Vance* fails to disclose or teach at least the above emphasized claim elements. Specifically, Applicant respectfully submits that *Vance* fails to disclose a flexible "upper shaft portion comprising external threads" as recited in amended claim 1. *Vance* allegedly discloses a flexible cutter or tap apparatus, but the cutting in *Vance* is performed by "a plurality of elongated openings 24," which are patentably distinct from the recited "external threads" of claim 1. Although *Vance* discloses "an indented annular area of reduced diameter 19," this does not disclose or teach "external threads." Further, *Vance* does not disclose or teach the upper shaft portion being "anchored in a tissue of the living body with the external threads." Therefore, Applicant respectfully requests that claim 1 and its dependent claims be placed in condition for allowance.

Claim 12 recites:

12. A method of creating a passage in tissue comprising:
 - providing a flexible tap apparatus system comprising:
 - a flexible tap apparatus member, comprising:
 - a shaft having a first passage disposed axially therein, a lateral passage extending laterally from said first passage to an outer surface of said shaft, a flexible upper shaft portion, and a flexible lower shaft portion;

said upper shaft portion comprising ridges and
said lower shaft portion having a
substantially smooth surface; and
a dye;
engaging said flexible tap apparatus member
into the tissue;
communicating said dye to the tissue through
said first passage and said lateral passage;
disposing a guide pin into the tissue;
engaging said first flexible tap apparatus
member with said guide pin;
boring a passage in the tissue with said
first flexible tap apparatus member;
removing said first flexible tap apparatus
member;
engaging said second flexible tap
apparatus member with said guide pin; and
boring into said passage in the tissue with
said second flexible tap apparatus member.

(Emphasis added).

Applicant respectfully submits that the rejection of independent claim 12 has been rendered moot by the addition of the above emphasized claim elements from dependent claim 13. The Office Action indicated that dependent claim 13 would be allowable if rewritten in independent form. Therefore, Applicant believes that claim 12 as amended is in condition for allowance.

Due to the shortcomings of the *Vance* reference described in the foregoing, Applicant respectfully asserts that *Vance* does not anticipate Applicant's claims. Therefore, Applicant respectfully requests that the rejection of these claims be withdrawn.

Because independent claim 1 is allowable over *Vance*, dependent claims 2-4, 6, and 14 are allowable as a matter of law for at least the reason that the dependent claims 2-4, 6, and 14 contain all elements of their respective base claim.


See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Additionally, these claims

recite other features that can serve as an independent basis for patentability.

CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, and similarly interpreted statements, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



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